



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,029	08/18/2003	Christopher D. Smith	555255012441	3221

89441 7590 09/01/2010
Jones Day (RIM) - 2N
North Point
901 Lakeside Avenue
Cleveland, OH 44114

EXAMINER

DARNO, PATRICK A

ART UNIT	PAPER NUMBER
----------	--------------

2158

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

09/01/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

dlpejeau@jonesday.com
portfolioprossecution@rim.com

DETAILED ACTION

1. Claims 67-83 are new. Claims 18-53 are canceled. Claims 1, 54, 61, and 66 are amended. Claims 1-22, 24, and 27 are pending in this office action.

Response to Amendment

2. The reply filed on 06/23/2010 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s):

The reply submitted by the Applicant is now directed to two different inventions. In most cases, this would result in an election by original presentation by the Examiner, however, due to the nature of the amendment, it cannot be easily decided which grouping of claims is the group originally claimed by the Applicant. Therefore, as noted above, the response is held as not fully responsive and the Applicant is required to either amend all groups of claims such that all groups of claims are directed to the same invention or the Applicant must elect one of the three groups of claims. For further information consult MPEP § 821.03 and 37 C.F.R.

1.145

The first group is claims 1-17 and 54-60. This group of claims is directed to system for triggering a provision event using a provisioning request message generated by an external system, wherein the provisioning request message being a format-independent electronic message capable of being constructed by and interpreted by a plurality of different external systems.

The second group is claims 61-83. This group of claims is directed to a system wherein "the provisioning request message is capable of specifying a different request to provision

entities on multiple systems using multiple schemas for identifying an entity and wherein the provisioning request message identifies an entity and one or more performable actions.

In previous office actions, the Examiner had believed that the claim limitations reproduced above which draw a distinction between the two groups were generally the same. As a result, in previous office actions, the Examiner grouped the rejections of claims 1 and 61 together as being recited over the same prior art references.

However, the Applicant has indicated that this approach taken by the Examiner was not proper because claim 61 includes limitations that claim 1 does not. Upon further review of the claims, the Examiner agrees with the Applicant that claim 61 contains limitations which are not found in claim 1. And the Examiner now asserts that restriction is proper because the claims 1 and 61 are directed to two different inventions, with different limitations, and a different scope. As noted above, Applicant appears to implicitly assert that claims 1 and 61 are directed to two different inventions in the following passage reproduced from Applicant's response received 06-23-2010:

In rejection claim 61, the Office does not address the provisioning request message being capable of specifying a request to provision entities on multiple systems using multiple schemes for identifying an entity. **The Office cites to the rationale of claim 1 in rejection claim 61. However, claim 1 does not recite this feature.** [Applicant's Response Received 06-23-2010, pgs. 15-16]

The different scope of claim 61 requires a different search than that which was performed for independent claim 1 because independent claim 61 is directed to a different invention, reciting limitations which are not found in independent claim 1. Since it appears that a different search needs to be performed for the independent claims belonging to the first and second groups, restriction of the claims is proper.

See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick A. Darno whose telephone number is (571) 272-0788. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on (571) 272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mohammad Ali/
Supervisory Patent Examiner, Art Unit 2158

/Patrick A. Darno/
Examiner

Application/Control Number: 10/643,029
Art Unit: 2158

Page 5

Art Unit 2158
08-27-2010

PAD